

REMARKS

The following remarks are responsive to the Office Action of June 8, 2007.

In the Office Action dated June 8, 2007, a restriction requirement under 35 U.S.C. § 121 was set forth requiring the Applicants to elect a single invention for examination. According to the Office Action, the groups of inventions being restricted were indicated as follows:

Species I: Figure 2

Species II: Figure 4

Species III: Figures 5 and 6

First, it is submitted that claims 1-10, 18 and 19 read on Species I. Furthermore, it is submitted that claims 11-13 read on Species II. Lastly, it is submitted that claims 14-17 and 20-22 read on Species III. Although the Applicants disagree with the restriction requirement, nevertheless, the Applicants elect, *with traverse*, Species I. Claims 11-17 and 20-22 are withdrawn from consideration at this time. However, the Applicants respectfully request rejoinder of claims 11-17 and 20-22 with elected claims 1-10, 18 and 19 in view of the following remarks that support the Applicants' position with respect to traversing the restriction.

35 U.S.C. § 121 states, *inter alia*, "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." First, the Applicants respectfully submit that the present application does not claim independent and distinct inventions. In support of the Applicants' position, the Applicants point to, for example, the BRIEF DESCRIPTION OF THE DRAWINGS section, which states, "FIG. 2 is a flow chart for explaining a method of concealing image information in a digital camera according to a *first preferred embodiment* of the present invention." (emphasis added) Furthermore, this section states, "FIG. 4 is a flow chart for explaining a method of concealing image information in a digital camera according to a *second preferred embodiment* of the present invention." (emphasis added) Moreover, this section states, "FIG. 5 is a flow chart for explaining a method of concealing image information in a digital camera according to a *third preferred embodiment* of the present invention." (emphasis added) As can be appreciated from the specification, the claims are directed to various embodiments of the same invention, not different inventions as the Office Action alleges.

Even if, for argument's sake, the various embodiments could be considered independent inventions, the Applicants submit that first, second and third embodiments are not distinct. The Office Action states that, "The species are independent or distinct because each Species contains different modes/steps of concealing image information." The Applicants respectfully disagree and point out that the differences between the first, second and third embodiments of the Applicants' method shown in FIGS. 2, 4 and 5, respectively (which correspond to the Examiner-defined Species I, II and III) relate generally to when the "ASSIGN PASSWORD" step or steps is/are performed during the methods. Although steps of a method claim are necessarily listed one after another, the order in which the steps appear in the claim language ordinarily does not impose an implicit limitation that the steps be performed in the same sequence as they appear in the claim. See *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315, 66 USPQ2d 1429, 1434 (Fed. Cir. 2003) In view of the foregoing, it can be appreciated that the order of steps is not sufficient as a basis for alleging distinctiveness between the various embodiments. Accordingly, the Applicants respectfully request rejoinder of claims 11-17 and 20-22 with elected claims 1-10, 18 and 19.

Finally, the Applicants submit that the restriction requirement is still not proper. As stated in MPEP 803, "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction is not required." MPEP 803 further states that, "Examiners ***must provide reasons and/or examples to support conclusions***, but need not cite documents to support the restriction requirement in most cases." (emphasis added) Since the Office Action has not provided reasons and/or examples to support the restriction criteria, the Applicants submit that the present restriction is improper and request withdrawal of the same. If the Office maintains the restriction in the next action, the Applicants respectfully request that the Office provide reasons and/or examples with specificity sufficient to support a prima facie case of distinctiveness/independence of inventions and burden.

In re Appl. of Kim et al.
Application No. 10/804,533
Response to Office Action of June 8, 2007

This application is believed to be proper form for examination and an early favorable action on the merits is requested. The Examiner is requested to call the undersigned attorney if that would be helpful in resolving any matters that might remain.

Respectfully submitted,



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Date: July 6, 2007

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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION OF JUNE 8, 2007 (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: July 6, 2007

A handwritten signature in cursive script, reading "I. Mikitiouk".

Irina L. Mikitiouk

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